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10/782,645	02/19/2004	Vanadis Mack Crawford	RSW920040012US1	4115

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IBM CORP. (WSM)  
c/o WINSTEAD SECHREST & MINICK P.C.  
P.O. BOX 50784  
DALLAS, TX 75201

EXAMINER
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MILLER, ALAN S

ART UNIT	PAPER NUMBER
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3624

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10/14/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/782,645	<b>Applicant(s)</b> CRAWFORD ET AL.	
	<b>Examiner</b> ALAN MILLER	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. This action is in response to the Amendment filed on 8/19/2009, in regards to the Non Final Office Action sent 5/29/2009, in regards to application filed 2/19/2004.

Claims 9 – 24 are pending and have been examined.

This action has been made FINAL.

***Response to Amendment***

2. Under the new guidelines set forth by

[http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25\\_interim\\_101\\_instructions.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf), the previous 35 U.S.C. § 101 rejections of claims 9 - 24 have been withdrawn.

***Response to Arguments***

3. Applicant's arguments filed 8/19/2009 in regards to the 35 U.S.C. §112, first paragraph rejections of claims 9 – 24, sent out on 5/29/2009, have been fully considered but they are not persuasive.

In respect to claims 9 - 16, Applicant argues that "While the particular phrase "a computer readable medium" may not be found in the Specification, there is language directed to a computer program product (see, e.g., paragraph [0005] of Applicants' Specification) which necessarily implies the teaching of a computer readable medium". Examiner respectfully disagrees.

The term computer program product does **not** necessarily imply the teaching of a computer readable medium. A computer program product can be merely a computer program

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*per se*, or merely a signal, and therefore, a computer program product does **not** implicitly or inherently or expressly disclose ‘a computer readable medium having computer executable code recorded thereon’, as recited in the preamble. Further, it has been held that when the written description does not explicitly disclose a limitation added to a claim, “it must be shown that a person of ordinary skill in the art would have understood, at the time the application was filed, that the description **requires** that limitation” (*Hyatt v. Boone*, 47 USPQ2d 1128).

Further, it has been held that what would have been obvious to one of ordinary skill in the art **is not the test**. Possession of the invention must be shown by the written description and “does not extend to subject matter not disclosed but that would have been obvious over what is expressly disclosed” (*Lockwood v. American Airlines Inc.* 41 USPQ 1961). Since a “computer program product” does not **require** a computer readable medium having computer executable code recorded thereon, the 35 U.S.C. §112, first paragraph rejection of claims **9 - 11 and 13 – 16** is **maintained**.

In respect to claims 17 – 24, Applicant argues that “Additionally, in connection with the aspect of a processor not being mentioned in the Specification, there is language directed to a computer program product (see, e.g., paragraph [0005] of Applicants' Specification) which necessarily implies the teaching of a computer. All computers have a processor, and as a result, undue or unreasonable experimentation is not required to practice the invention claimed in claims 17 and 21”. Examiner respectfully disagrees.

The term computer program product does **not** necessarily imply the teaching of a processor. A computer program product can be merely a computer program *per se*, or merely a signal, and while all computers have processors, a computer program product is **not** a computer,

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and does **not** implicitly or inherently or expressly disclose a computer, hardware, or a processor, as recited in the preamble. Further, it has been held that when the written description does not explicitly disclose a limitation added to a claim, “it must be shown that a person of ordinary skill in the art would have understood, at the time the application was filed, that the description **requires** that limitation” (*Hyatt v. Boone*, 47 USPQ2d 1128).

Further, it has been held that what would have been obvious to one of ordinary skill in the art **is not the test**. Possession of the invention must be shown by the written description and “does not extend to subject matter not disclosed but that would have been obvious over what is expressly disclosed” (*Lockwood v. American Airlines Inc.* 41 USPQ 1961). Since a “computer program product” does not **require** a processor, the 35 U.S.C. §112, first paragraph rejection of claims **17 - 20 and 21 – 24** is **maintained**.

4. Applicant's arguments filed 8/19/2009 in regards to the 35 U.S.C. 103 rejections over Kinra et al. (U.S 5,731,991) and over Kinra et al. (U.S 5,731,991) in view of Wolfram MathWorld have been fully considered but they are not persuasive.

Applicant incorrectly states, on pages 10 - 12 of Applicant's Response, and throughout the response, that “The Examiner cites elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 112 and 124 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4; Office Action (5/29/2009), page 8.” However, page 8 of the latest Non Final Office Action, filed 5/29/2009, to which Applicant filed this response, does NOT cite elements 114a-114c and 126a-126d of Kinra

as teaching the claimed customer interest categories and further cites elements 112 and 124 of Kinra as teaching the claimed supplier metrics. Page 8, from the 5/29/2009 Office Action states

“computing partial scores for the customer interest categories by weighting and summing the numerical values; and (see at least column 4, lines 33-68, wherein Kinra discloses weighing each criterion (i.e. *customer interest categories*) and summing the values to produce a raw criterion score (i.e. *computing partial scores for the customer interest categories by weighting and summing the numerical values* ). Examiner notes that since for each criterion a partial score is computed by weighing and summing numerical values, a partial score is generated for each criterion (i.e. *customer interest categories*); therefore, it computes partial scores for the criterion (i.e. customer interest categories) by weighting and summing the numerical values);

determining an overall score for the software product requirement from the partial scores(see at least column 9, lines 6-13, wherein Kinra discloses determining a total score for each product (*i.e. software product requirement*). Examiner notes that the overall score is determined using the previously found partial scores (i.e. *from the partial scores*)).

Kinra does not explicitly disclose the labels “supplier metrics” and “customer interest categories”. However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels, because such data does not functionally relate to the steps in the method claimed and because the

subjective interpretation of the data does not patently distinguish the claimed invention.”

Nowhere in the latest Office Action, filed 5/29/2009, does Examiner “cite elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 112 and 124 of Kinra as teaching the claimed supplier metrics”. Applicant goes on to state, on page 11, that “Instead, Kinra teaches computing normalized scores for the prototyping and simulation criterion which the Examiner asserts teaches the claimed supplier metrics”, however, again, in the latest Office Action, dated 5/29/2009, nowhere does Examiner relate prototyping and simulation criteria to supplier metrics.

Applicant has *failed to address* the latest rejections of claims 9 – 24 in respect to Kinra as put forth in the Non Final Office Action dated 5/29/2009. As such, Examiner will make a *bona fide* attempt to respond to the arguments as best as possible, though most do not apply to the latest Action.

As stated in the previous Office Action’s Response to Arguments, in regards to Applicant's argument that Customer Interest Categories is not equal to Criterion, Examiner respectfully disagrees. Applicant’s specification does not explicitly define Customer Interest Categories; it merely provides examples. Using broadest reasonable interpretation, Examiner interpreted Customer Interest Categories as criteria most important to a user, or a customer. As disclosed in Kinra, column 1, lines 62 – 65, the user (i.e. the customer) can emphasize which criteria in software products are most important to the user. Examiner notes that a customer is one who purchases and uses a product, and therefore, the criteria are of what interests the

customer, i.e. customer interest categories, and therefore Examiner equated Criterion with “customer interest categories”.

Again, as stated in the previous Office Action’s Response to Arguments, in response to the argument that Supplier Metrics not equal to Categories, Examiner respectfully disagrees. Applicant’s specification does not explicitly define Supplier Metrics; it merely provides examples. Using broadest reasonable interpretation, Examiner interpreted Supplier Metrics as a measure of the supplier against which the user criterion are measured (e.g. evaluating each category for criterion), and since the categories supply the weights to the criterion, similar to the “supplier metrics” (see at least column 5, lines 37 – 48, which discloses each category is defined by a group of related evaluation criteria...each category weighting value reflects the relative importance to the category of the functional capacities or features specified in a criterion (i.e. *customer interest category*)), and each category is evaluated for the criterion (i.e. *evaluating supplier metrics for customer interest category*) to get the weighting value (i.e. *to provide numerical values*), Examiner equated Categories to “supplier metrics”.

In further regards to both arguments, see also column 5, lines 37 – 48, which discloses each category (i.e. *supplier metric*) is defined by a group of related evaluation criteria (i.e. *customer interest categories*)...each category (i.e. *supplier metric*) weighting value reflects the relative importance to the category (i.e. *supplier metric*) of the functional capacities or features specified in a criterion (i.e. *customer interest category*). Each category is evaluated for the criterion (i.e. *evaluating supplier metrics for customer interest category*) to get the weighting value (i.e. *to provide numerical values*); see also column 1, lines 64 - 65, which discloses that the system allows the user to emphasize which criteria are most important to the user (i.e. *customer*).



Since the user (i.e. *the customer*) defines the criterion (i.e. *categories*) that are most important to the user (i.e. *the customer*), the criteria relate to an interest of the customer (i.e. *customer interest categories*). Therefore, Examiner has clearly tied **Categories** to supplier metrics, and **Criterion** to customer interest categories.

Applicant further argues, on Page 12 of Applicant's Remarks, that

"The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowry* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106.01. That is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in *Kinra*. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowry* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to music, literary works, and a compilation or mere arrangement of data. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is not related to music, literary works, a compilation or mere arrangement of data. Neither is this claim limitation an abstract idea. Neither is this claim limitation protectable under copyright law. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the customer interest categories. These are defined to be selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability. This

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is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.”

Examiner respectfully disagrees.

Applicant refers to MPEP 2106.01, which in turn refers to what is patentable under 35 U.S.C. 101, and has since been superseded by New Interim Patent Subject Matter Eligibility Examination Instructions ([http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25\\_interim\\_101\\_instructions.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf)). Further, Examiner was not rejecting the claims based on non functional descriptive material in regards to 35 U.S.C. 101, Examiner was rejecting them under 35 U.S.C. 103, as disclosed by **MPEP 2112.01(III)**, which does refer to *In re Gulack*, and therefore, Examiners reliance on *In re Gulack* was proper.

In further regards to the arguments regarding ‘Customer Interest Categories’ and ‘Supplier Metrics’ and other rejections regarding non-functional descriptive material, such as claims 10 and 18, and 11 and 19, Examiner notes these are merely labels given to describe variables, and that this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), and that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels, because *such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the labels does not patentably distinguish the claimed invention*. Changing the labels will in no way affect how the system multiplies and adds the numbers. The labels only have **subjective, human interpretation**. Further, Applicant has offered no evidence to how these labels have any **functional relationship to the system**, and

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merely argues that they are not related to music, literary works or abstract ideas, nor has offered any evidence to how changing the labels would affect how the system performed the function of determining scores by weighting and adding numbers. The system will perform the weighting and adding regardless of how the categories or metrics are labeled.

In regards to the argument on pages 15 – 17, that normalizing is not the same as averaging the non-zero partial scores, Examiner respectfully disagrees.

Applicant broadly claims “wherein the step of determining includes a step of averaging non-zero partial scores”. Average is a broad term that is not explicitly defined by Applicants specification. Using broadest reasonable interpretation, Examiner used the dictionary definition that states that an AVERAGE is a “single value (as a **mean**, mode, or median) that summarizes or represents the general significance of a set of unequal values **b: MEAN** a: an estimation of or approximation to an arithmetic mean” (see Merriam-Webster, <http://www.merriam-webster.com/dictionary/average>).

Applicant further refers to a dictionary definition of ‘normalizing’, and asserts that “Kinra teaches normalizing a score by dividing the raw score by the sum of the associated criterion weighting values. Normalizing is not the same as averaging the non-zero partial scores”. Examiner notes that Kinra discloses “the criterion score is normalized *in the sense that* the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion” (column 4, lines 32 – 68), and further discloses the steps being taken as multiplying each number by it's weight, summing those weighted scores together, and then dividing by the sum of the weights (column 4, lines 32 – 68); this is known as a WEIGHTED MEAN, since the scores are multiplied by their weights,

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summed, and then divided by the sum of the weights, which is how a WEIGHTED MEAN is determined; see attached <http://www.statistics.com/resources/glossary/w/wmean.php>, which defines a WEIGHTED MEAN, and since a the definition of AVERAGE includes MEAN, a WEIGHTED MEAN is therefore an AVERAGE, and regardless of how Kinra refers to it, the steps taken are those taken to determine a WEIGHTED MEAN, and therefore, determining an AVERAGE. And further, since this step is done before the final score is determined, Kinra therefore discloses the claimed limitation “wherein the step of determining includes a step of averaging non-zero partial scores”.

Applicant’s further arguments in regards to the 103 rejection over Kinra and over Kinra in view of Wolfram Mathworld recite the same arguments that have been addressed above.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims **9 -24** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims **9** and **13** recite the limitation 'a computer program product having a computer readable medium', however, Examiner is unable to find any mention in Applicant's Specification of 'a computer readable medium'. Correction or clarification is required.

Claims **17** and **21** recite the limitation ‘determining...by a processor’, however, Examiner is unable to find any mention in Applicant’s Specification of a ‘processor’, or hardware that might encompass a processor. Correction or clarification is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **9-12 and 17 – 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinra et al. (U.S 5,731,991, hereinafter Kinra).

In respect to claims **9 and 17**, Kinra discloses:

evaluating supplier metrics customer interest categories to provide numerical values for a software product requirement (see at least column 5, lines 37 – 48, which discloses each category (i.e. *supplier metric*) is defined by a group of related evaluation criteria (i.e. *customer interest categories*)...each category (i.e. *supplier metric*) weighting value reflects the relative importance to the category (i.e. *supplier metric*) of the functional capacities or features specified in a criterion (i.e. *customer interest category*). Each category is evaluated for the criterion (i.e.

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*evaluating supplier metrics for customer interest category*) to get the weighting value (i.e. *to provide numerical values*); see also column 1, lines 64 - 65, which discloses that the system allows the user to emphasize which criteria are most important to the user (i.e. *customer*). Since the user (i.e. *the customer*) defines the criterion (i.e. *categories*) that are most important to the user (i.e. *the customer*), the criteria relate to an interest of the customer (i.e. *customer interest categories*));

computing partial scores for the customer interest categories by weighting and summing the numerical values; and (see at least column 4, lines 33-68, wherein Kinra discloses weighing each criterion (i.e. *customer interest categories*) and summing the values to produce a raw criterion score (i.e. *computing partial scores for the customer interest categories by weighting and summing the numerical values* ). Examiner notes that since for each criterion a partial score is computed by weighing and summing numerical values, a partial score is generated for each criterion (i.e. *customer interest categories*); therefore, it computes partial scores for the criterion (i.e. *customer interest categories*) by weighting and summing the numerical values);

determining an overall score for the software product requirement from the partial scores(see at least column 9, lines 6-13, wherein Kinra discloses determining a total score for each product (i.e. *software product requirement*). Examiner notes that the overall score is determined using the previously found partial scores (i.e. *from the partial scores*)).

Kinra does not explicitly disclose the labels “supplier metrics” and “customer interest categories”. However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not

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distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patently distinguish the claimed invention.

In respect to claims **10 and 18**, Kinra discloses exemplary criterion (*i.e. customer interest categories*) that include ease of use (*i.e. usability*), application interoperability (*i.e. interoperability*), automated testing, and application partitioning (*i.e. capability*), application specifications, physical data definition, prototyping and simulation, and normalized category score (see at least column 4, lines 1-4 and FIG 2, 112).

Kinra does not explicitly disclose the labels performance, reliability, maintainability, documentation, and serviceability.

However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels to describe the criterion, because such data does not

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functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

In respect to claims **11 and 19**, Kinra discloses evaluation categories (*i.e. supplier metrics*) integration, construction, reuse, business issues, development, operations, architecture, design, analysis, planning, etc (FIG. 2, 60, 62, 64, 66, 68, column 7, lines 30-47).

Kinra does not explicitly disclose the labels market penetration, priority as determined by a customer, revenue potential, and state of technology advancement.

However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels to describe the categories, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

In respect to claims **12 and 20**, Kinra discloses wherein the step of determining includes a step of averaging non-zero partial scores (see at least column 4, lines 40-68, wherein Kinra discloses a normalized score calculated by dividing the raw score by the sum of the



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associated criterion weighting values (*i.e. averaging non-zero partial scores*)). Examiner notes that the normalizing done by Kinra is a weighted mean, which is type of average (see <http://www.statistics.com/resources/glossary/w/wmean.php> and <http://www.merriam-webster.com/dictionary/average>) .

9. Claims **13-16 and 21 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinra et al. (U.S 5,731,991, hereinafter Kinra) in view of Wolfram MathWorld (<http://mathworld.wolfram.com>, <http://mathworld.wolfram.com/MatrixTrace.html> and <http://mathworld.wolfram.com/Matrix.html> , copyright 1999-2008, hereinafter Wolfram MathWorld).

In respect to claims **13 and 21**, Kinra discloses:

evaluating supplier metrics customer interest categories to provide numerical values for a software product requirement (see at least column 5, lines 37 – 48, which discloses each category (*i.e. supplier metric*) is defined by a group of related evaluation criteria (*i.e. customer interest categories*)...each category (*i.e. supplier metric*) weighting value reflects the relative importance to the category (*i.e. supplier metric*) of the functional capacities or features specified in a criterion (*i.e. customer interest category*). Each category is evaluated for the criterion (*i.e. evaluating supplier metrics for customer interest category*) to get the weighting value (*i.e. to provide numerical values*); see also column 1, lines 64 - 65, which discloses that the system allows the user to emphasize which criteria are most important to the user (*i.e. customer*). Since the user (*i.e. the customer*) defines the criterion (*i.e. categories*) that are most important to the

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user (i.e. *the customer*), the criteria relate to an interest of the customer (i.e. *customer interest categories*));

computing partial scores for the customer interest categories by weighting and summing the numerical values; and (see at least column 4, lines 33-68, wherein Kinra discloses weighing each criterion (i.e. *customer interest categories*) and summing the values to produce a raw criterion score (i.e. *computing partial scores for the customer interest categories by weighting and summing the numerical values* ). Examiner notes that since for each criterion a partial score is computed by weighing and summing numerical values, a partial score is generated for each criterion (i.e. *customer interest categories*); therefore, it computes partial scores for the criterion (i.e. *customer interest categories*) by weighting and summing the numerical values);

determining an overall score for the software product requirement from the partial scores(see at least column 9, lines 6-13, wherein Kinra discloses determining a total score for each product (i.e. *software product requirement*). Examiner notes that the overall score is determined using the previously found partial scores (i.e. *from the partial scores*)).

Kinra does not explicitly disclose the labels “supplier metrics” and “customer interest categories”. However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels, because such data does not functionally relate to the steps

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in the method claimed and because the subjective interpretation of labels does not patently distinguish the claimed invention.

Kinra does not explicitly disclose the technique of forming an  $N$  by  $M$  matrix  $A$ , multiplying by an  $M$  by  $N$  matrix  $W$ , or determining the overall score from the diagonal elements of  $P$ .

Wolfram MathWorld discloses that matrix creation, the multiplication of two matrices and the trace of a square product matrix (i.e. *determining the overall score from the diagonal elements of  $P$* ) are old and well known.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the technique of calculating the scores in Kinra with the old and well known equivalent technique of creating matrices and the multiplication of two matrices and the trace of a square product matrix since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results of arriving at the same results, since neither applicant's specification nor his arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement (*Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)). Further, it has been held that express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious (*In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)).

In respect to claims **14 and 22**, Kinra discloses exemplary criterion (*i.e. customer interest categories*) that include ease of use (*i.e. usability*), application interoperability (*i.e. interoperability*), automated testing, and application partitioning (*i.e. capability*), application specifications, physical data definition, prototyping and simulation, and normalized category score (see at least column 4, lines 1-4 and FIG 2, 112).

Kinra does not explicitly disclose the labels performance, reliability, maintainability, documentation, and serviceability.

However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels to describe the criterion, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patently distinguish the claimed invention.

In respect to claims **15 and 23**, Kinra discloses evaluation categories (*i.e. supplier metrics*) integration, construction, reuse, business issues, development, operations, architecture, design, analysis, planning, etc (FIG. 2, 60, 62, 64, 66, 68, column 7, lines 30-47).

Kinra does not explicitly disclose the labels market penetration, priority as determined by a customer, revenue potential, and state of technology advancement.

However these differences are only found in the nonfunctional material and are not functionally involved in the steps recited. The evaluating, computing and determining steps would be performed regardless of the data, e.g. labels. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 217 USPQ 401 (Fed. Cir. 1983);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use any labels to describe the categories, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

In respect to claims **16 and 24**, , Kinra discloses wherein the step of determining includes a step of averaging non-zero partial scores (see at least column 4, lines 40-68, wherein Kinra discloses a normalized score calculated by dividing the raw score by the sum of the associated criterion weighting values (*i.e. averaging non-zero partial scores*)). Examiner notes that the normalizing done by Kinra is a weighted mean, which is type of average (see <http://www.statistics.com/resources/glossary/w/wmean.php> and <http://www.merriam-webster.com/dictionary/average>).

However, Kinra does not explicitly disclose averaging the non-zero diagonal elements of P.

Examiner notes that the diagonal elements of the matrix P contain the same scores calculated by the invention of Kinra (e.g. the trace of a square matrix).

Wolfram MathWorld discloses that a trace of a square matrix (*i.e. diagonal elements of  $P$* ) is old and well known (see Matrix-Trace from Wolfram MathWorld).

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the technique of calculating the scores and then taking the average of the scores in Kinra with the old and well known equivalent technique of computing the trace of a square product matrix and then taking the average since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results of arriving at the same results, since neither applicant's specification nor his arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement (*Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007). Further, it has been held that express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious (*In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)).

### ***Conclusion***

10. The prior art made of record and not relied upon considered pertinent to Applicant's disclosure.

- a. Statistics.com (<http://www.statistics.com/resources/glossary/w/wmean.php>) which discloses a definition of a weighted mean.

- b. Merriam-Webster (<http://www.merriam-webster.com/dictionary/average>) which discloses a definition of average.
- c. Nakano et al. (U.S. Patent Pub. 2002/0184082) discloses a customer satisfaction evaluation method.
- d. Lee (U.S. Patent 5,765,137) discloses correlating product requirements to manufacturing cost.
- e. Zelek et al. (U.S. Patent Pub. 2003/0040954) discloses a method and system for product optimization.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN MILLER whose telephone number is (571)270-5288. The examiner can normally be reached on Mon - Fri, 10:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BRADLEY BAYAT can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. M./  
Examiner, Art Unit 3624

/Bradley B Bayat/  
Supervisory Patent Examiner, Art Unit 3624